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Serial No.: 09/635,330
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REMARKS

Applicant's undersigned attorney wishes to thank the Examiner for the courtesy of the telephone interview conducted between the Examiner and applicant's attorney on July 16, 2008. All of the amendments to the claims as set forth herein are based on the telephone interview. In view of the above amendments and remarks to follow, reconsideration and allowance of this application are respectfully requested.

Claims 1-3, 8-10, 14, 16, 18, 20, 24-26, 30-34, 40-44, 49, 50 and 62 were rejected under 35 U.S.C. 103(a) as being unpatentable over Downing et al. (Downing) (US Patent 5,963,647) in view of Risafi et al. (Risafi) (US Patent 6,473,500) and further in view of Tadcsco et al. (Tadcsco) (US Patent 6,085,888).

Each of the independent claims has been amended to state, in one form or another, that the device pick-up code that is used by the beneficiary to obtain the money transfer device is associated with a specific customer transaction and not with other transactions and also that it is a single-use code. Hence, the pick-up code cannot be the beneficiary's name and also cannot be used by the beneficiary multiple times. Nor can the code be used multiple times to access the same account or anything else for that matter. Instead, a separate, different code (e.g. PIN) is needed to access the funds by employing the money pickup device. The independent claims also state that the account which is accessed upon use of the money pickup device corresponds to the original transaction (i.e., the money provided by the customer).

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During the interview, the Examiner indicated that the claimed invention may be distinguished from (i.e., patentable over) the cited references if the details of the device pickup code are recited in the claims. As herein presented in the independent claims, the device pick up code has a number of features as discussed above. And it is submitted that the cited references, either alone or in combination, do not disclose or suggest a device pick up code (within the claimed process/system) with such features. The references are discussed below in connection with the codes disclosed therein.

Downing, which has been discussed in detail in applicant's prior submissions, entails the transfer of money from a sender to a beneficiary by employing multi-use codes, including the secret code and the transfer reference number that are referred to by the Examiner in the section entitled "Response to Arguments" in the Office Action under reply. (Office Action, page 2, lines 13-17). More particularly, Downing explicitly teaches that the codes are used by the beneficiary multiple times in order for the beneficiary to carry out multiple withdrawals from the transferred account. (column 7, lines 34-36). Hence, the codes in Downing cannot correspond to Applicant's claimed device pick-up code. Moreover, and equally as important, the device pick-up code in the present invention is not used to immediately obtain money by the beneficiary. Rather, multiple steps are required wherein a device pick-up code is first supplied to the beneficiary, the beneficiary then presents the device pick-up code to a distributor who only then supplies the beneficiary with a money transfer device and corresponding PIN which the beneficiary then uses to access the transferred funds. In Downing, money is directly provided upon use of the codes. Thus, the

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codes described in Downing cannot equate to or correspond in any manner to the claimed device pick-up code.

Risafi is silent with respect to employing a code to receive the ATM card. Risafi discloses that the user can assign a PIN in order to use the card. But this PIN is employed with usage of the card itself, not to obtain the card. Applicant previously speculated in a prior response that a recipient may have to show identification (e.g., driver's license) to obtain the card. However, as specifically recited in the claims, the claimed device pick-up code is associated with the specific money transfer transaction. Clearly, identification showing the beneficiary's name (or other ID of the beneficiary) does not have such an association. Moreover, the same ID would be used by the beneficiary to retrieve another ATM card in a subsequent occurrence of the process disclosed in Risafi and thus is not a single-use code of any sort. Hence, Risafi, like Downing, neither discloses nor suggests the recited device pick-up code having the recited features discussed above.

Tedesco teaches a person inputting a code in a vending machine (to access an account) to obtain a good (e.g., newspaper) without the need to use cash. But this code is used repeatedly (e.g., each day) until the account is finally depleted. Such a code therefore appears to be analogous to a PIN used to access funds in a depleting account. Hence, the code in Tedesco does not correspond to Applicant's claimed single use device pick-up code.

Moreover, and while this issue was already addressed by the Examiner, Tedesco's code is not used to obtain a money pick-up device, but rather is used to spend money from a depleting account to obtain a good (that clearly cannot be used to obtain money). This is a

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contrary objective and thus it is improper to equate entering a code into a vending machine with applicant's claimed device pick-up code (where the device is used to access money). In any event, the code that is entered into the vending machine is used multiple times.

From the foregoing discussion and analogies, it is submitted that all of the codes employed in the three cited references correspond, at most, to a PIN (or the like) which is used to access funds from a depleting financial account (with or without also simultaneously using an ATM card).

Moreover, KSR is instructive in connection to the current rejection of the claims. KSR expressly instructs that it remains legally insufficient to conclude that a claim is obvious just because each feature of a claim can be independently shown in the cited references. See *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385 (U.S. April 30, 2007). When the obviousness rationale is the combination of prior art elements according to known methods to yield predictable results, as the Examiner has done here, the combination is obvious only if each of the prior art elements (used in the proposed combination) performs the same function as it does outside the combination (i.e., separately). Using this standard set forth in KSR, when the elements of the three cited references are combined in a manner such that each element performs the same function as it did in the respective cited reference, the resulting combination would produce steps and features that are, at best, relevant to steps and features that are carried out *after* the beneficiary has presented the distributor with the single-use device pickup code. Hence, the combination of the cited references would not produce a process (or system) that includes steps pertaining to

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the beneficiary providing to a distributor (of the money transfer company) of the single-use device pick-up code having certain characteristics, as discussed above, as well as activating the money pick-up device by the distributor upon receiving that single-use device pickup code.

Stated differently, any attempt to combine the cited references to produce a process that includes the claimed single-use device pickup code (having the characteristics already addressed) requires that the particular function of a code disclosed in any of the cited references be substantially modified, which contradicts the KSR holding.

In view of the foregoing, it is therefore submitted independent claims 1, 8, 14, 18, 24, 33 and 42, and claimed dependent thereon, are patently distinct and unobvious over the combination of Downing, Risafi and Tedesco.

In addition, and notwithstanding the above-presented statements, it is submitted that the cited references sufficiently teach away from one another so as to make their combination improper. KSR expressly instructs that it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does and the those reasons must be articulated to evidence a proper rejection. See *Id.* Although the motivation to modify the prior art can come from many different fields, some motivation is needed. Accordingly, the arguments previously submitted are incorporated herein by reference (i.e., Downing teaches "cardless withdrawal" whereas Risafi is directed to use of money cards).

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Finally, it is further noted that while Downing does state that the cardless withdrawal process disclosed therein may employ an ATM machine that can also accept cards, the Downing invention nonetheless is about transferring money without a card. Hence, the invention itself in Downing is contradictory to a process that employs cards, which would result in one of ordinary skill in the art NOT combining the respective teachings of such references. In the absence of clear articulation of why one of ordinary skill in the art would make the combination, a rejection based upon a combination of such references appears improper.


In view of the foregoing, and particularly since even the combination of the cited references would not produce the claimed invention (as amended herein) as discussed above, it is respectfully requested that the rejection of the pending claims be withdrawn.

New claims 63 and 64 are presented. The allowance of claims 63 and 64 are solicited.

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In light of the foregoing amendments and remarks, reconsideration and allowance of this application are respectfully requested.

Respectfully submitted,

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